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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/813,402

03/31/2004

Gabor Bajko

59643.00338

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32294

7590

10/27/2008

SQUIRE, SANDERS & DEMPSEY L.L.P.

8000 TOWERS CRESCENT DRIVE

14TH FLOOR

VIENNA, VA 22182-6212

EXAMINER

HO, DUC CHI

ART UNIT

PAPER NUMBER

2419

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DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/813,402	<b>Applicant(s)</b> BAJKO ET AL.	
	<b>Examiner</b> DUC C. HO	<b>Art Unit</b> 2419	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 July 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-12, 14-24 and 26-55 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 53 and 54 is/are allowed.
- 6) ☒ Claim(s) 1-5, 12, 14-16, 20-24, 26-35, 38, 42-44, 48-52, and 55 is/are rejected.
- 7) ☒ Claim(s) 6, 7, 9-11, 17-19, 36, 37, 39-41 and 45-47 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>7-29-08</u> .   | 6) <input type="checkbox"/> Other: _____                          |

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1. Claims 50-52 and 55 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding claim 50, the subject matter "A computer program, embodied on a computer readable medium" was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The same remark applies to claims 51-52, and 55.

***Claim Objections***

2. Claim 4 is objected to because of the following informalities: Regarding claim 4, Applicant is requested to change "trusted networks" in line 3 to --- trusted network ---, for consistency with singular usage of "trusted network" in claim 1.

Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 1-3, 8, 12, 14-16, 20-24, 26-33, 38, 42-44, 48-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over the admitted prior art in paragraphs 0007-0015 of the instant application, hereinafter referred to as the APA.

Regarding claim 1, the APA discloses private extensions to SIP that enable a network of trusted SIP servers to assert the identity of end users or end systems in the RFC 3325.

According to the APA, there is a need to detect the trustworthiness of the next hop network. If the next hop is trusted, then the procedures related to the different privacy options are delegated to the next hop. In other words, the APA suggests a

determining step to find out whether the next hop or the called party in the next hop is trusted or not, see 0011-0013.

If the next hop network is not trusted in the APA, the privacy procedures need to be executed by modifying at least one message for the called party.

The Internet Protocol Multimedia (IM) domain supports the Session Initiation Protocol (SIP). SIP message uses private extensions that enable a network of trusted SIP servers (in the first network or home network) to assert the identity of end users or end systems (in the second network). If the caller asks for identity privacy, which is the case the end users or end systems are not in the trusted network, the home network of the caller has to remove the header, such that the P- Asserted-Identity field in the header of a message has to be removed before it reaches the called party, see 0014-0015.

The APA, however, does not teach a step of determining, in a first network, and address associated with a called party of a second network.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to employ a mechanism for finding an address associated with a called party of a second network or the next hop network, and whether the address is in a trusted network, into the system of the APA. The suggestion/motivation for doing so would have been to provide a measure of privacy to protect the user or the caller's identification if the address of the called party is not in the trusted database.

Regarding claim 2, detecting the trustworthiness of the next hop network involves determining the address associated with the called network or the address of the next hop network, see 0013.

Regarding claim 3, the message to be sent to the called network or the next hop network should be in a packet form including fields in the headers.

Regarding claim 8, in the APA, the IM domain supports the Session Initiation Protocol (SIP), see 0011. The entities addressed by SIP are user at hosts and they are identified by a SIP URL, in which the URL takes a form such as user@host where the user part can be a user name or telephone number and the host would be either a domain name or a network address. Therefore, the network address of the host could be determined if it contains a domain or not.

Regarding claim 9, in the APA at 0015, a proxy server according to the RFC 3325, could remove all the P-Asserted-Identity header field values if the user requested that this information be kept private, when the called party is not in the trusted network.

However, the APA does not teach discarding the at least one message for the called party.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to employ a mechanism discarding at least one message sending from the caller to the called party into the system of the AP if the called party is an untrusted network. The suggestion/motivation for doing so would have been to protect the privacy of the caller's identification.

Regarding claim 14, the APA discloses modifying the message for the called party by removing the identity of the user, see 0014-0015.

Regarding claim 15, the APA discloses removing the identity by removing the P-asserted-Identity header, see 0015.

Regarding claim 16, the APA discloses the use of SIP for operating a call between a caller and a called party at the next hop.

Regarding claim 20, the claim has similar limitations as claim 1. Therefore, it is rejected under the APA for the same reasons set forth in the rejection of claim 1. A

system configured in the APA to perform the claimed steps should include a first and a second determiner.

Regarding claim 21, the claim has similar limitations as claim 1. Therefore, it is rejected under the APA for the same reasons set forth in the rejection of claim 1. An apparatus configured in the APA to perform the claimed steps should include a first and a second determiner.

Regarding claims 32-33, the claims have similar limitations as claims 2-3, respectively. Therefore, they are rejected under the APA for the same reasons set forth in the rejection of claims 32-33.

Regarding claim 38, the claim has similar limitations as claim 8. Therefore, it is rejected under the APA for the same reasons set forth in the rejection of claim 8.

Regarding claims 42-44, the claims have similar limitations as claims 12-15, respectively. Therefore, they are rejected under the APA for the same reasons set forth in the rejection of claims 12-15.

Regarding claim 22, the APA discloses private extensions to SIP that enable a network of trusted SIP servers to assert the identity of end users or end systems in the RFC 3325.

According to the APA, there is a need to detect the trustworthiness of the next hop network. If the next hop is trusted, then the procedures related to the different privacy options are delegated to the next hop. In other words, the APA suggests a determining step to check if the end user network at the next hop is a trusted one, see 0011-0013.

If the next hop network is not trusted in the APA, the privacy procedures need to be executed by modifying at least one message for the called party.

The Internet Protocol Multimedia (IM) domain supports the Session Initiation Protocol (SIP). SIP message uses private extensions that enable a network of trusted SIP servers (in the first network or home network) to assert the identity of end users or end systems (in the second network). If the caller asks for identity privacy, which is the case the end users or end systems are not in the trusted network (corresponding to there is no secure connection), the home network of the caller has to remove the header, such that the P- Asserted-Identity field in the header of a message has to be removed before it reaches the called party, see 0014-0015.

However, the APA does not teach determining, in a first network, if there is a secure connection with a second network.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to employ a mechanism for finding an address associated with a called party of a second network or the next hop network, and whether the address is in a trusted network so as to establish a secure connection, into the system of the APA. The suggestion/motivation for doing so would have been to provide a measure of privacy to protect the user or the caller's identification.

Regarding claim 23, in the APA, the suggested determining step could be performed in a gateway, see 0008.

Regarding claim 24, in the APA, the gateway that performs the suggested determining step could be called as a security gateway. Its name represents a function of establishing a trusted connection between two trusted endpoints of a call.

Regarding claim 26, the claim has similar limitations as claim 20. Therefore, it is rejected under the APA for the same reasons set forth in the rejection of claim 20. An apparatus configured in the APA to perform the claimed steps should include a first and a second determiner.



Regarding claim 27, the claim has similar limitations as claim 22. Therefore, it is rejected under the APA for the same reasons set forth in the rejection of claim 22.

Regarding claim 48, in the APA, the suggested determining step could be performed in a gateway, see 0008.

Regarding claim 49, in the APA, the gateway that performs the suggested determining step could be called as a security gateway. Its name represents a function of establishing a trusted connection between two trusted endpoints of a call.

Regarding claim 28, the APA suggests a determining step to detect whether the next hop is a trusted network. In other words, determining whether the next hop being trusted or not is equivalent to determining if there is a secure connection with another network, see 0013.

Regarding claim 29, the claim has similar limitations as claims 1, 12, and 23-24. Therefore, it is rejected under the APA for the same reasons set forth in the rejection of claim 1, 12, 23-24.

Regarding claim 30, the claim has similar limitations as claim 29. Therefore, it is rejected under the APA for the same reasons set forth in the rejection of claim 29.

Regarding claim 31, the claim has similar limitations as claim 29. Therefore, it is rejected under the APA for the same reasons set forth in the rejection of claim 29.

6. Claims 4-5, and 34-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over the APA, in view of Donaldson (US 6,321,267).

Regarding claim 4, the APA discloses all claimed limitations, except a step of checking if the address is contained in a database of trusted networks.

Donaldson discloses method and apparatus for filtering junk email. An active filtering proxy server running a process 1104 interposed between remote hosts on the Internet 1100-fig.7 and a mail host 1105. The server includes a trusted database 1093-

fig.7 used to identify trusted networks that are permitted to bypass further filtering, i.e. whitelist DB which contains individual email addresses, see col.4, lines 17-36.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to employ a database containing trusted networks taught by Donaldson into the system of the APA. The motivation for doing so would have been to check whether the address of the called party contained in a database of a trusted network or not, in order to provide a measure of privacy to protect the user or the caller's identification.

Regarding claim 5, if the called party of the APA is in the trusted network, checking if the address is in the whitelist database as taught by Donaldson, see col.4, lines 17.

Regarding claims 34-35, the claims have similar limitations as claims 4-5, respectively. Therefore, they are rejected under the APA for the same reasons set forth in the rejection of claims 4-5.

### ***Response to Arguments***

7. Applicant's arguments with respect to claims 1, 20-21, and 26 have been considered but are moot in view of the new ground(s) of rejection.

### ***Allowable subject matter***

8. Claims 53-54 are allowed.

Art Unit: 2419

9. Claims 6-7, 9-11, 17-19, 36-37, 39-41, 45-47 are objected to as being independent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Conclusion***

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Duc Ho whose telephone number is (571) 272-3147. The examiner can normally be reached on Monday through Thursday from 7:30 am to 6:00 pm.

If attempt to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jay Patel, can be reached on (571) 272-2988.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-2600.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2419

11. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Patent Examiner

/DUC C HO/

Primary Examiner, Art Unit 2419

10-21-08